



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,719	09/20/2002	James Robl	103080-P08-058	2839

1473 7590 08/07/2006

FISH & NEAVE IP GROUP  
ROPES & GRAY LLP  
1251 AVENUE OF THE AMERICAS FL C3  
NEW YORK, NY 10020-1105

EXAMINER

WOITACH, JOSEPH T

ART UNIT	PAPER NUMBER
----------	--------------

1632

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



**UNITED STATES DEPARTMENT OF COMMERCE**

**U.S. Patent and Trademark Office**

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

10/070,719

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

EXAMINER
----------

ART UNIT	PAPER
----------	-------

20060804

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

See attached.

Art Unit: 1632

### **DETAILED ACTION**

This application filed September 20, 2002, is a 371 national stage filing of PCT/US00/25090, filed September 14, 2000.

Applicants' amendment filed May 17, 2006 has been received and entered. The specification has been amended. Claims 1-50 have been canceled. Claims 51-53 have been added. Claims 51-53 are pending.

### ***Election/Restrictions***

The amendment filed on May ,2006 canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected invention because they are drawn to a new and different patentably distinct invention.

Applicant's election with traverse of Group II in the reply filed on July 22, 2005 was acknowledged. In the first action, groups I and II were rejoined. Applicants do not traverse the restriction of other groups, and the restriction requirement of these groups is maintained for the reasons of record. The requirement was deemed proper and is therefore made FINAL. The elected invention encompassed by rejoined groups I and II was drawn to a method of producing an unmodified and a genetically modified embryonic stem cell, comprising method steps of nuclear transfer where the donor cell and recipient oocyte are from different animal species. The newly added claims are directed to a separate method for enhancing the efficiency of cross

Art Unit: 1632

species nuclear transfer comprising method steps which would have been restricted if first presented in the original claims. While it would be acknowledged that each is generally drawn to using cross species nuclear transfer methodology, the starting materials, the specific method steps, and the outcome of the two inventions are materially different. The search and consideration of the two inventions would require a different search and consideration of relevant art for each of the two methods.

Applicants note that the newly added claims are within the scope of claim 1, and as such correspond to the subject matter of the elected invention. See Applicants' amendment, top of page 6. Such is not persuasive. Initially it is noted that neither the original claims, nor amendments during prosecution recited steps for "incorporating mitochondria or mitochondrial DNA" into the recipient oocyte in the practice of making embryonic stem cells. Further, while the specific method steps now recited are technically encompassed by the open language of the previous claims, the scope of the present claims for consideration is different and in part much broader with respect to the end since all aspects of "enhancing efficiency" of nuclear transfer would have to be considered, versus using the method to generate embryonic stem cells. The present claims do not even recite nor require that embryonic stem cells are made. At best the two inventions can be said to be related as mutually exclusive species in an intermediate-final product relationship in view of US standards of restriction practice (noting the present application is a 371 national stage filing). Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the end product of the instantly claimed method is a one cell embryo versus embryonic stem cells derived therefrom. The

Art Unit: 1632

intermediate product is deemed to be useful as an embryo that could be used for development of an live animal or for the derivation of other differentiated cell types and the inventions are deemed patentably distinct because there is nothing on this record to show them to be obvious variants.

Finally, it is noted that the art would support that methods of nuclear transfer can be practiced in mammals where the isolation and derivation of embryonic stem cells has yet to be successfully practiced. In general, research in areas of embryonic stem cells and nuclear transfer comprise two separate concepts. Though generally provided together in the elected invention, the newly added claims clearly shift the invention into the focus of nuclear transfer. Inventions can be restricted under PCT Rule 13.2 when they lack the same or corresponding special technical feature because invention has no special technical feature that defined the contribution over the prior art. Further, multiple different products and/or different methods can be restricted, though unity of invention between different categories of inventions will be found to exist if specific combinations of inventions are present. Those combinations include:

- 1) A product and a special process of manufacture of said product.
- 2) A product and a process of use of said product.
- 3) A product, a special process of manufacture of said product, and a process of use of said product.
- 4) A process and an apparatus specially designed to carry out said process.
- 5) A product, a special process of manufacture of said product, and an apparatus specially designed to carry out said process.

In this case, the claimed inventions fail to meet either criteria.

Art Unit: 1632

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

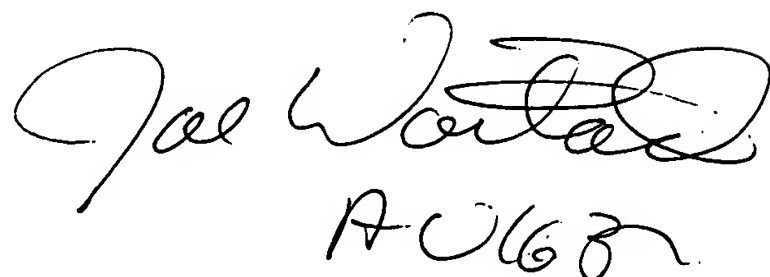
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (571) 272-0739.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached at (571) 272-0735.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (571) 272-0532.

Joseph T. Woitach



ACUG